

### REMARKS

This Amendment is in response to the Final Office Action dated January 26, 2005. In the Office Action, the Examiner rejected claims 10-15, 32-35, 53-56, and 77-79 under 35 U.S.C. § 102(b) as being clearly anticipated by Payton, U.S. Patent No. 5,790,935 (hereinafter *Payton*).

Claims 10-15, 33, 53, 54, 56, 77 and 78 are amended as shown above. Specifically, independent claims 10, 53, and 77 are amended to more clearly recite features of the claimed invention. Claims 10-15, 32-37, 53-56, and 77-79 remain pending in the application. For the reasons set forth below, the Applicant respectfully requests reconsideration and allowance of all pending claims.

### ARGUMENT IN SUPPORT OF ALLOWANCE OF CLAIMS

#### Claim Rejections - 35 U.S.C. § 102

A claim is anticipated only if each and every element of the claim is found in a single reference. M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the claim." M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989)).

With respect to the rejection of independent claim 10, as previously presented, the Examiner states,

Referring to claim 10, Payton discloses receiving, at a client, content descriptors (see Column 6, Lines 7-11 for receiving a recommended list), which descriptor content from a server (see Column 5, Lines 12-16 for the server creating the recommended list).

Payton also discloses generating demand data related to the content described by the content descriptors (see Column 6, Lines 7-9 for displaying/generating the recommended list, which represents demand data related to content/movies selectable by the user that are described by the recommended list/content descriptors).

Payton also discloses sending demand data feedback from the client to the server (see Column 6, Lines 51-55) after demand data related to a predetermined amount of content is generated (see Column 6, Lines 29-30 for the user demanding the data by making a request, and that the

data requested is represented by a digital item 36, which includes videos). The examiner notes that a video has a predetermined running time, for example, a movie can run anywhere from an hour, hour and a half, or two hours. Therefore, the demand data is inherently related to a predetermined amount of content (predetermined running time) that is generated (requested to be viewed).

The Examiner further states, "Referring to claims 32-37, see the rejection of claims 10-15, respectively." Independent Claim 32 is a Beauregard claim (claiming software embodied as instructions) for performing the method of independent claim 10; claim 10 has been amended herein, while independent claim 32 has not. Accordingly, the Examiner's argument in support of the rejection of the previous version of claim 10 is applicable to the present version of claim 32.

Applicant respectfully asserts that the Examiner's interpretation of the claim element "sending demand data feedback from the client to the server after demand data related to a predetermined amount of content is generated" does not fall within the comports of the what is specified for claim interpretation in the MPEP or applicable guidelines identified by the Federal Circuit Court of Appeals (FCCA). With regard to claim interpretation, the MPEP states:

**MPEP 2173.05a**

**I. <THE MEANING OF EVERY TERM SHOULD BE APPARENT**

The meaning of every term used in a claim should be apparent from the prior art or from the specification and drawings at the time the application is filed. Applicants need not confine themselves to the terminology used in the prior art, but are required to make clear and precise the terms that are used to define the invention whereby the metes and bounds of the claimed invention can be ascertained. During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). See also MPEP § 2111 - § 211.01. When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relations to the prior art (*In re Zletz*, 893 F. 2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). (Emphasis Added)

Also, MPEP 2111 (Claim Interpretation; Broadest Reasonable Interpretation) states, in part,

During patent examination, the pending claims must be "given \*>their< broadest reasonable interpretation consistent with the specification." In re Hyatt, 211 Fed 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

*The broadest reasonable interpretation of the claims must also be consistent with the interpretation those skilled in the art would reach.* (Emphasis added)

while MPEP 2111.01 (Plain Meaning) states, in part

II. <"PLAIN MEANING" REFERS TO THE >ORDINARY AND CUSTOMARY< MEANING GIVEN TO THE TERM BY THOSE OF ORDINARY SKILL IN THE ART

**\*\*>Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. . . . It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. . . . In construing claim terms, the general meanings gleaned from references sources, such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the invention. . .**

First, Applicant respectfully asserts that no person of ordinary skill in the art would, without looking at the present specification, interpret the claim element, "sending demand data feedback from the client to the server after demand data related to a predetermined amount of content is generated" in the manner interpreted by the Examiner. Second, when this claim element is considered in view of the present specification, it is clear that the Examiner's claim interpretation does not comport with applicable patent prosecution practice. Additionally, the Examiner's interpretation of this claim element is inconsistent with interpretation of other elements contained in several of the dependent claims, as argued in further detail below.

The demand data in claims 10 and 32 relate to feedback concerning the level of demand for various content for a given client. This is specifically identified in the claim

element, "sending demand data feedback from the client to the server after demand data related to a predetermined amount of content is generated." Furthermore, from the preceding claim element, "generating demand data related to the content described by the content descriptors," it is clear that demand data is generated for the content described by the content descriptors.

Under the Examiner's interpretation of claim 10 (and claims 32, 53, and 77 by analogy), the demand data is data used to make a request to view a digital item, such as a video. However, in rejecting depending claim 11 (and thus dependent claim 33), the Examiner states, "*Payton* discloses that the generation of the demand data comprises consuming at least a portion of content locally stored by the client (see Column 7, Lines 13-25 for determining if a movie is stored at the local storage 56 or at the remote storage 34), the generation of demand data responsive to the portion of content that is consumed (see Column 6, Lines 36-50 for generating demand data based on the content that is consumed by a subscriber).

Claim 33 recites,

33. The article of manufacture of claim 32 wherein the machine-readable medium further has instructions to consume at least a portion of content locally stored, *the demand data generated in response to the portion of content that is consumed.* (Emphasis added).

When combined with the claim elements in base claim 32, this clearly states, that the demand data is generated in response to a portion of content that is consumed, and *such* demand data is sent after demand data related to a predetermined amount of *such* content being consumed has been generated. While *Payton* generates data identifying content that a user has viewed via a local server (and optionally, rating data entered by a viewer after reviewing the content (Co. 6, lines 36-38)), *Payton* does not disclose or fairly suggest sending such data to a server after a predetermined amount of such data is generated. Rather, under *Payton*, demand data feedback is sent to the

central distribution server 24 in response to a request from the central distribution server to send such data. There is no decision-making operation made by the local server on when to send this data, and certainly such data is not sent after a predetermined amount of it is generated.

As stated from Col. 7, line 61 to Col. 8, line 5,

As shown in FIG. 4, each local server's predictive filter 54 updates its list 44 of recommended items in response to both a local periodic refresh via the backchannel 30 (step 108) and a broadcast over the digital transport system 26 (step 110). In response to the periodic trigger, the local server 28 determines whether new subscriber profile data or billing data exists (step 112). If new data does exist, the local server dials up the distribution server 24 to establish a communication channel (step 114). The prediction filter sends the new profile and billing data back to the distribution server 24 (step 116) and receives the prediction ratings and newly recommended items from the server 24 (step 118). (Emphasis added)

With respect to dependent claim 13, and by analogy claim 34, the Examiner states,

Referring to claim 13, *Payton* discloses sending demand data to the server after demand data related to a first number of pieces of content have been generated (see Column 6, Lines 48-50 for using a subscriber's viewing habits to augment a subscriber profile, therefore, since viewing habits are being monitored and stored in a user profile, and then the profile being transmitted to the server at Column 6, Lines 51-55, the demand data (represented by a viewer's profile) is related to a first number of pieces of content that have been viewed/generated).

As is clear from above, *Payton* only sends demand data from a local server to the central server in response to a periodic trigger by the local server. Accordingly, it is clear that *Payton* does not "send(ing) demand data to the server after demand data related to a first number of pieces of content have been generated." The number of pieces of content for which the demand data would be generated would be purely

random for a given local server based on how many pieces of content had been viewed and/or rated since the last periodic trigger.

In view of the foregoing, it is clear that no reasonable argument can be supported that *Payton* teaches or fairly suggests the element of "sending demand data feedback from the client to the server after demand data related to a predetermined amount of content is generated."

In view of the foregoing arguments, it is clear that at least one of claims 32, 33, and 34, was improperly finally rejected. As such, a final Office Action for the present application was Improper.

With respect to the present amendments made to independent claims 10, 53, and 77, these amendments are made to more clearly recite the subject matter of the respective claims. Although these independent claims have been amended, independent claim 32 has not. Accordingly, the Examiner may not deny entry of these amendment on the basis of the amendments changing the scope of the respective independent claims such that a new search is required in view of the fact that independent claim 32 has not been amended. Accordingly, Applicant requests the examiner reconsider independent claim 32 as a separate issue.

#### Conclusion

Overall, none of the references singly or in any motivated combination disclose, teach, or suggest what is recited in the independent claims. Thus, in view of the foregoing argument, independent claims 10, 32, 53, and 77 are in condition for allowance. The dependent claims that depend directly or indirectly on these independent claims are likewise allowable based on at least the same reasons and based on the recitations contained in each dependent claim.

If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any

Informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

*Charge Deposit Account*

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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